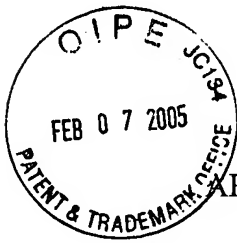


1/24/05



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Slutz et al.

SERIAL NO.: 10/627,931

GROUP ART UNIT: 1775

FILED: July 25, 2003

EXAMINER: Turner

FOR: CVD DIAMOND-COATED COMPOSITE SUBSTRATE CONTAINING A
CARBIDE-FORMING MATERIAL AND CERAMIC PHASES AND
METHOD FOR MAKING SAME

ATTORNEY DOCKET NO.: 52993/279473

I hereby certify that this correspondence is being deposited with the
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VA 22313-1450 on February 2, 2005

Angela M. Rossi

Commissioner for Patents
P. O. Box 1450 Alexandria,
VA 22313-1450

DATE: February 2, 2005

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Responsive to the Office action dated December 2, 2004, Applicants
respectfully submit the following.

The Examiner has required a six-way restriction between groups of claims.
Applicants elect the invention of Group I, claims 1-15 and 45-48. This election is
made with traverse, however.

The Examiner states that Groups I and II (and Groups IV – VI) are related as
intermediate-final product, and alleges that the intermediate product (presumably the

invention of Group I, although the Examiner never fully explains this) is useful to make “a piston.” Applicants respectfully submit that the Examiner has failed to meet her burden in establishing the distinctness required before a restriction can be made. MPEP § 806. Groups I and II are not related as intermediate – final product, as the Examiner alleges, but as subcombination – combination. The CVD diamond-coated composite of Group I does not lose its identity when it is used to form a polishing pad conditioning head, as recited in the claims of Group II. Yet such a loss of identity is precisely what is required for the composite to meet the definition of an “intermediate.” Put another way, the composite and the conditioning head do not have a “mutually exclusive species relationship.” MPEP § 806.04(b).

Because Group I and Group II are related as combination – subcombination, the Examiner must establish 2-way distinctness before a requirement for restriction can be proper. MPEP § 806.05(c). However, the Examiner cannot establish this level of distinctness, because the claims of Group II clearly depend from a claim of Group I. Put another way, the combination clearly depends upon the particulars of the subcombination for patentability.

Since the Examiner has failed to meet her burden on showing distinctness, for this reason alone restriction is improper, and should be withdrawn. Applicants remarks do not constitute any admission that the groups of claims are obvious variants. In addition to being counterfactual, such an admission is unnecessary where the Examiner has failed to satisfy her initial burden to show patentable distinctness.

In addition, the Examiner has failed to establish any undue burden resulting from the presence of both groups of claims in a single application. To do a complete

search of the invention of Group II, the Examiner would have to search the invention of Group I. Conversely, if the composite of Group I is found to be patentable, then combinations of the composite with other elements to form a conditioning head must, ipso facto, also be patentable. As a result, there is no undue burden imposed on the Examiner by treating both groups of claims in a single application.

Similar arguments about distinctness and undue burden hold for claims IV – VI.

Since the requirement for restriction made by the Examiner is improper, withdrawal thereof is respectfully requested. An early and favorable action on the merits is earnestly solicited.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Order Account No. 11-0855.

Respectfully submitted,



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